IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Attorney Docket No.: Google-65 (GP-171-00-US)

Appl. No.: 10/732,824

Confirmation No.: 6777

Applicants: **Kenneth W. BRONSON, et al.**

Filed: **December 10, 2003**

Title: **DETERMINING CONTENT TO BE PROVIDED BY AN ENTITY FOR RENDERING VIA A RESOURCE IN A TARGET DOCUMENT OR NOTIFYING AN ALTERNATIVE ENTITY OF THE AVAILABILITY OF THE RESOURCE**

TC/A.U.: **2168**

Examiner: **Aaron J. Sanders**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

The applicants request that the Panel review this application before Appeal. A Notice of Appeal is filed concurrently herewith. An Appeal Brief has not been filed.

REMARKS/ARGUMENTS

Claimed Invention

Embodiments consistent with the claimed invention determine, with a first entity and responsive to an ad request, whether the content included in a target document can be analyzed by the first entity to determine if an ad relevant to the content of the target document is available for rendering. If the content cannot be analyzed by the first entity, indicating, by the computer

system of the first entity, the availability of at least a portion of the first resource of the first target document to a second entity.

The Outstanding Rejection

Claims 1-3, 5, 9, 10, 17, 18, 20-25, 27-31, 36, 37 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0054589 ("the Nicholas publication"), in view of U.S. Patent No. 6,665,658 ("the DaCosta patent").

Claims 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Nicholas publication, in view of the DaCosta patent, and in view of U.S. Patent Application Publication No. 2003/0131095 ("the Kumhyr publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 11-16, 41 and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Nicholas publication, in view of the DaCosta patent, and in view of U.S. Patent Application Publication No. 2004/0044571 ("the Bronnimann publication").

Clear Errors

Independent claims 1 and 36, as amended, are not rendered obvious by the Nicholas publication and DaCosta patent since the cited references neither teach, nor make obvious, *determining, with a first entity and responsive to an ad request, that the content included in a target document cannot be analyzed by the first entity to determine if an ad relevant to the content of the target document is available for rendering.*

In rejecting previously presented claim 1, the Examiner states:

> Nicholas teaches *"determining, by the computer system of the first entity and responsive to the first ad request, [demographic information of the user] to determine if an ad relevant to the content of the first target document is available for rendering,"* see Fig. 25 and par. 103, "A determination of demographic information related to user is then made during a stage S418 of the flowchart 410. . . *Based on the demographic determination, ad selection node 140 checks for an ad based on the demographic information during a stage S420 of the flowchart 410."*
> [Emphasis added.]

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(Paper No. 20100217, page 3) The Examiner concedes that:

> Nicholas does not teach *"determining... that the first target document
> cannot be analyzed by the first entity."*

(Paper No. 20100217, page 3) To address this admitted deficiency, the Examiner cites the

DaCosta patent and states:

> DeCosta teaches that conventional web crawlers cannot crawl (i.e.
> "analyze") dynamic web sites, see col. 1, 1. 46 - col. 2, 1. 2. Thus,
> it would have been obvious to one of ordinary skill in the database
> art at the time of the invention for Nicholas to additionally
> determine the crawlability of the target document *because*
> *DeCosta's teachings would have allowed Nicholas' method to*
> *ignore web sites it cannot properly analyze,* see DeCosta col. 1, 1.
> 46 - col. 2, 1. 2. [Emphasis added]

(Paper No. 20100217, page 3) The applicants respectfully disagree.

In the Nicholas publication, "[a] determination of demographic information related to [a]

user is ... made." (Paragraph [0103] of the Nicholas publication) Based on the demographic

determination, "ad selection node 140 checks for an ad based on the demographic information."

If an "appropriate targeted ad" (based on the demographic determination) does not exist in the

Nicholas publication, "ad selection node 140 may forward the request for an ad to a default

service from content provider node 130." (Paragraph [0103] of the Nicholas publication) Thus,

as can be appreciated from the foregoing, the Nicholas publication does not consider or describe

a situation where the target document cannot be analyzed.

Meanwhile, the portion of the DaCosta patent cited by the Examiner provides:

> The main problem is that these *dynamic web sites* provide valuable
> content and information, *which is not possible to automatically*
> *gather and index using existing technologies.* However, it would
> be very valuable if this data were available and indexed for other
> meta search engines to search. [Emphasis added.]

(Column 1, lines 46-48 of the DaCosta patent) The DaCosta patent further clarifies the reasons

its inventors believe that "existing technologies" were not able to "automatically gather and

index" dynamic web sites:

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> The standard web crawler *is not able to systematically crawl the site and replicate the database because of the need for user interaction.* There is no mechanism to simulate the user's behavior, or interaction, during a typical search session. [Emphasis added.]

(Column 1, line 67 through column 2, line 2 of the DaCosta patent) The DaCosta patent attempts to address this issue by developing a "method for a web crawler to automatically simulate user interaction with a dynamic website in order to gather and extract information from the site." (Abstract of the DaCosta patent)

In view of the foregoing, the applicants respectfully disagree with the rationale the Examiner provides for modifying the Nicholas publication in view of the DaCosta patent (See, e.g., Paper No. 20100217, page 3.). Specifically, *since the Nicholas publication "checks for an ad based on the demographic information"*, the Nicholas publication does not need to "determine the crawlability" of a Web site to determine its contents for the purposes of determining content-relevant ads. (Paragraph [0103] of the Nicholas publication) Furthermore, the Nicholas publication describes advertising on dynamically generated Web pages and states:

> One embodiment includes communicating the ad information to a java server page (JSP), an active server page (ASP), or any other such dynamically generated web page, resource, or service known in the art.

(Paragraph [0099] of the Nicholas publication) As can be appreciated from the foregoing, the alleged "solution" of the DaCosta patent does not address a problem in the Nicholas publication since the Nicholas publication "includes communicating the ad information to ... dynamically generated web page[s]". Therefore, one skilled in the art would not have combined the references as proposed by the Examiner.

Thus, since the Nicholas publication and the DaCosta patent neither teach, nor make obvious, determining that the content included in an accessible target document cannot be analyzed by the first entity to determine if an ad relevant to the content of the target document is available for rendering, and since one skilled in the art would not have combined the references as proposed by the Examiner, claims 1 and 36 are not rendered obvious by the cited references. Since claims 2, 3, 5, 9, 10, 17, 18, 20-25, 27-31 and 39, as amended, directly or indirectly depend from claim 1, and since claim 37 depends from claim 36, these claims are similarly not rendered obvious by the cited references.

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Further with respect to dependent claims 11, 12, 41 and 42, these claims are not rendered obvious by the cited references for the reasons presented in the Request for Reconsideration filed on July 2, 2010.
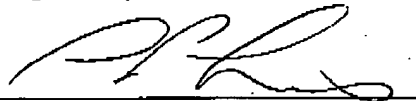
Reservations

The applicants reserve their right to Appeal any rejections, as well to present any arguments and evidence, regardless of whether or not they were presented in this request.

Conclusion

In view of the foregoing remarks, the applicants respectfully request that the Panel allow the application on the existing claims. Alternatively, the applicants respectfully request that the Panel reverse the outstanding grounds rejection of the claims and direct the Examiner to send an appropriate (e.g., non-final) Office Communication consistent with the Panel's decision.

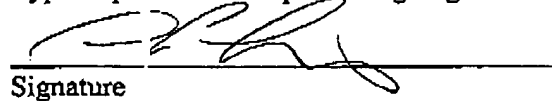Respectfully submitted,

August 2, 2010

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patent Office on the date shown below.

Leonard P. Linardakis
Type or print name of person signing certification

Signature   August 2, 2010
                                                             Date

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